

Applicants: James Binley et al.

Serial No.: 10/780,993

Filed: January 18, 2004

**Exhibit 3**

# Office Action Summary

Application No.

10/780,993

Applicant(s)

BINLEY ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 87-164 is/are pending in the application.
- 4a) Of the above claim(s) 114-125 and 153-158 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 87-113 and 126-152 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Notice to Comply...

**Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :03/30/2004; 07/09/2004; 12/08/2006; 01/22/2007.**

Serial No.: 10/780,993  
Applicants: Binley, J. M., et al.

Docket No.: 59331-E/JPW/AJD/BWSL  
Filing Date: 02/18/2004

### Detailed Office Action

#### *Status of the Claims*

Claims 87-164 are pending in the instant application. Applicants' election with traverse of Group I (claims 87-96, 11-113, 126-135, and 150-152) in the communication filed 08 December, 2006, is acknowledged. Applicants requested that Groups I, II, III, VI, and VIII should be rejoined because the inventions disclosed therein are all directed toward related subject matter. Upon review of the restriction requirement and consideration of applicants' argument, the examiner has decided to rejoin claims 97-110 and 136-149. Thus, claims 87-113 and 126-152, directed toward DNAs, vectors containing said DNAs, and host cells comprising said DNAs, are now under examination. Claims 114-125 and 153-158 stand are withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The claims stand withdrawn for the reasons of record clearly set forth in the last office action. The requirement as it pertains to these claims is still deemed to be proper and is therefore made FINAL.

#### *37 C.F.R. §§ 1.821-1.825*

This application contains sequence disclosures (e.g., see pages 30 and 55-57 of the specification and Figures 13-15) that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid

Sequence Disclosures. Any questions regarding compliance with the sequence rules requirements specifically should be directed to the departments listed at the bottom of the Notice to Comply. Applicants are reminded that all sequences contained in the specification, including the drawings, must be identified by a sequence identifier (SEQ ID NO.:). Appropriate correction is required. The specification is objected to because it fails to contain the appropriate sequence identifiers.

**37 C.F.R. § 1.121(d)**

The drawings are objected to because they fail to contain sequence identifiers for Figures 13-15. The drawings are also objected to because they are illegible and of generally poor quality (e.g., see Figures 1, 4, 7, etc.). Corrected drawing sheets in compliance with 37 C.F.R. § 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 C.F.R. § 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**37 C.F.R. § 1.125(a)**

A substitute specification excluding the claims is required pursuant to 37 C.F.R. § 1.125(a) because it contains numerous illegible page (e.g., see pages 2, 14, 22, 51, 61, 69, etc.). A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strikethrough except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

**Abstract**

The abstract of the disclosure is objected to because it fails to describe the salient characteristics of the claimed invention. The claims are directed toward a nucleic acid encoding a modified HIV-1 gp140 comprising the recited modifications. Appropriate correction is required. See M.P.E.P. § 608.01(b).

**35 U.S.C. § 120**

Applicants are reminded that the status of all applications relied upon under 35 U.S.C. § 120 should be updated (e.g., application no. 09/602,864 is now Patent No. 6,710,173). The reference to said application in the first first sentence(s) of the specification should be corrected.

**37 C.F.R. § 1.98**

The information disclosure statements filed 30 March, 2004, 09 July, 2004, 08 December, 2006, and 22 January, 2007, have been placed in the application file and the information referred to therein has been considered. Applicants are reminded that the listing of references in the specification is not a proper information disclosure statement. 37 C.F.R. § 1.98(b) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office, and M.P.E.P. § 609.04(a), subsection I. states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892 or applicants on form PTO-1449, they have not been considered.

***Nonstatutory Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not

identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 U.S.P.Q. 761 (C.C.P.A. 1982); *In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970); and *In re Thorington*, 418 F.2d 528, 163 U.S.P.Q. 644 (C.C.P.A. 1969). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) or § 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

Claims 87-113 and 126-152 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,710,173. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the '173 patent are directed toward nucleic acids encoding a modified HIV-1 envelope glycoprotein. The claims in this patent do not specify if the nucleic acid of interest is DNA or RNA. However, it would have been *prima facie* obvious to one of ordinary skill in the art to employ a DNA form of the nucleic acid since this



would enable one of ordinary skill in the art to readily manipulate the nucleic acids so they can be readily introduced into different cloning vectors and expression vectors.

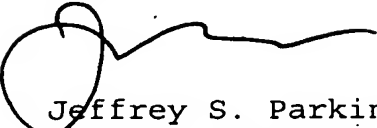
### Correspondence

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 10:30 AM to 9:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bruce R. Campell, Ph.D., can be reached at (571) 272-0974. Direct general status inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Applicants are reminded that the United States Patent and Trademark Office (Office) requires most patent related correspondence to be: a) faxed to the Central FAX number (571-273-8300) (updated as of July 15, 2005), b) hand carried or delivered to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 C.F.R. § 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System. This notice replaces all prior Office notices specifying a specific fax number or hand carry address for certain patent related correspondence. For further information refer to the Updated Notice of Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence, and Exceptions Thereto, 1292 Off. Gaz. Pat. Office 186 (March 29, 2005).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,



Jeffrey S. Parkin, Ph.D.  
Primary Examiner  
Art Unit 1648

05 March, 2007

## Notice to Comply

Application No.

10/780,993

Applicant(s)

Binley, J. M., et al.

Examiner

Jeffrey S. Parkin

Art Unit

1648

Paper No.

03/05/2007

### NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☒ 7. Other: applicants are reminded that Sequences appearing in the **specification** (e.g., see pages 30 and 55- 57) and/or **drawings** (e.g., see Figures 13-15) must be identified by a sequence identifier (SEQ ID NO.:) in accordance with 37 C.F.R. § 1.821(d). Sequence identifiers for sequences appearing in the drawings may appear in the Brief Description of the Drawings. Applicant must provide appropriate amendments to the specification and/or drawings inserting the required sequence identifiers. Extensive amendments may necessitate the submission of a substitute specification. If the requisite SEQ ID NOS.: are not present in the sequence listing, a substitute sequence listing will be required.

#### Applicant May Need to Provide:

- ☒ An substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
- For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for Patentin Software Program Help @ [ebc@uspto.gov](mailto:ebc@uspto.gov).

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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                              | CONFIRMATION NO.        |
|---|-------------|----------------------|--|-------------------------|
| 10/780,993  | 02/18/2004  | James M. Binley      | 59331-E/JPW/AJD/BWSL                             | 9456                    |
| <div>7590      03/09/2007</div> <div>John P. White<br/>Cooper &amp; Dunham LLP<br/>1185 Avenue of the Americas<br/>New York, NY 10036</div> |             |                      | <div>EXAMINER</div> <div>PARKIN, JEFFREY S</div> |                         |
|   |             |                      | <div>ART UNIT</div> <div>1648</div>              | <div>PAPER NUMBER</div> |
| SHORTENED STATUTORY PERIOD OF RESPONSE  | MAIL DATE   | DELIVERY MODE        |  |                         |
| 3 MONTHS  | 03/09/2007  | PAPER                |  |                         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.